

REMARKS

Claims 1-13 were originally submitted for consideration. Claims 12-13 were previously withdrawn from consideration. Claims 1-11 have been canceled and new claims 14-20 have been added. Applicants request reconsideration of the rejections in view of the following amendments and remarks. No new matter has been introduced in the present amendment.

Claim Rejections under 35 U.S.C., section 103

Claims 1-11 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. US2002/0188513A1 by Gil et al. (hereinafter 'Gil') and in view of Patent Application Publication No. US2003/0126000A1 by John A. Clendenin (hereinafter 'Clendenin'). Applicants have canceled claims 1-11 and submit new claims 14-20 for the Examiner's consideration. Applicants believe that claims 14-20 are allowable and the application is condition for allowance.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness. *In re Fine*, U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

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Applicants' new claim 14 recites a "system for facilitating supply chain processes in an outsourced manufacturing environment" including a manufacturing entity comprising a server, an outsourced supply chain tool executing on the server, and a terminal and a data storage device both in communication with the server via a communications link. Claim 14 further recites a network link to at least one contract manufacturer system and a network link to a customer focus team system that performs administrative services for the contract manufacturer system on behalf of the manufacturing entity. Claim 14 further recites that the administrative services include at least one of:

- "facilitating transfer and replenishment of components needed during manufacture;
- ensuring ongoing inventory demand issues are addressed and resolved;
- obtaining and providing metrics on outsourced supply chain parts and activities;
- assisting said at least one contract manufacturing system during shortfalls of supplies;
- collaborating with said commodity team council systems relating to acquisition of critical parts; and
- providing assistance on matters related to import, export, and tax issues."

Neither Gil nor Clendenin teach or disclose each of the elements provided in Applicants claim 14. Specifically, neither Gil nor Clendenin, alone or in combination, teach or recite a customer focus team system. Nor do they teach performing the administrative services listed above for a contract manufacturing system on behalf of a manufacturing entity. Gil discloses a reporting system for a supply chain that provides an enterprise and a partner that allows transactions to occur involving the two parties (see Gil Abstract). Gil further teaches a partner coordinator component 180 that includes EAI-based applications logic "for data transformation 264, event coordination 266 with enterprise applications and messaging connectivity back to the network domain 14" (page 13, paragraph 0129). Gil also discloses that partner coordinator component 180 "also

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may include cached data and business logic available to the enterprise application for real-time data validation and access" (page 13, paragraph 0129). The partner coordinator component taught by Gil provides a gateway for transmitting real-time information between an enterprise and a partner system but does not teach the administrative functions provided in Applicants claim 14. Thus, because Gil does not teach nor recite each of the elements of Applicants claim 14, it may not properly be relied upon as a reference. Claims 15-20 depend from what is an allowable claim 14. For at least the foregoing reasons, the claims 14-20 are allowable. Reconsideration is respectfully requested.

Alternatively, assuming for the sake of argument, that the cited references are applicable, Applicant respectfully maintains that the Examiner has used an improper standard in arriving at the rejection of the above claims under section 103, by failing to provide motivation for the suggested combination. "(E)ven assuming that all elements of an invention are disclosed in the prior art, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done." *Ex parte Levengood*, 28 U.S.P.Q. 1300 (Bd. Pat. App. Int. 1993). The references, when viewed by themselves and not in retrospect, must suggest the invention. *In Re Skoll*, 187 U.S.P.Q. 481 (C.C.P.A. 1975). The Examiner suggests that it would have been obvious to one of ordinary skill in the art, having the teachings of Gil and Clendenin before him at the time the invention was made, to modify Gil as taught by Clendenin to include specific hardware associated with the network of the Applicants' invention in order to "effectively coordinate execution of actions and events across a supply chain even as service and lead-time requirements become more stringent and partners come and go" (See Clendenin, Paragraph 0006). Applicants respectfully disagree. The explanation provided in the Office Action in this instance provides little justification or explanation for the suggested combination of the cited references. The rejection based on the suggested combination of references merely

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amounts to a compilation of the claimed elements without any suggestion or motivation for their combination. There are ~~no teachings in the art or the cited references that would have motivated one skilled in the art to make the suggested combination.~~ Therefore, the Examiner cannot establish a prima facie case for obviousness under §103(a). Thus, Claim 14 is allowable, and claims 15-20 are allowable as depending from an allowable base claim. Accordingly, the rejections are improper, and they should be withdrawn.

Moreover, Applicant respectfully maintains that the Examiner has used an improper standard in arriving at the rejection of the above claims under section 103, based on ~~improper hindsight which fails to consider the totality of Applicant's invention and to the totality of the cited references.~~ More specifically, the Examiner has used Applicant's disclosure to select portions of the cited references to allegedly arrive at Applicant's invention. In doing so, the Examiner has failed to consider the teachings of the reference or Applicant's invention as a whole in contravention of section 103.

For at least the foregoing reasons, Applicants claims 14-20 are allowable. Reconsideration is respectfully requested.

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

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In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicant's attorney hereby authorizes that such fee be charged to Deposit Account No. 09-0458.

Respectfully submitted,

CANTOR COLBURN LLP

By Marisa J. Dubuc

Marisa J. Dubuc
Registration No. 46,673
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No. 29371

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